

**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

**REJECTIONS UNDER 35 U.S.C. §103(a) ARE OVERCOME**

Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. The issue under §103 is whether the PTO has stated a case of *prima facie* obviousness. "The PTO has the burden under §103 to establish a *prima facie* case of obviousness." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To satisfy this burden, the PTO must meet the criteria set out in M.P.E.P. §706.02(j):

...three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Moreover, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

**§ 103(a) as allegedly unpatentable over Lepage et al. in view of Saillet et al.**

Claims 1-11, 13, and 15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lepage et al. (U.S. Patent No. 6,457,265; hereinafter "Lepage") in view of Saillet et al. (U.S. Patent No. 6,938,362; hereinafter "Saillet"). This rejection is respectfully traversed.

According to the Office Action, Lepage relates to a sports boot for gliding boards comprising a rigid core as a first part, an envelope of supple material as a second part, and a reinforcement means. The Office Action contends that Lepage does not disclose the material or synthetic fibers being embedded in a matrix, but alleges that Saillet relates to a reinforcement

boot wherein one of the layers of the sandwich structure is made of a composite material based on woven or nonwoven fiber included in a matrix. The Office Action asserts that it would have been obvious to one of ordinary skill in the art to make the reinforcement means of Lepage using a thermoplastic matrix as taught in Saillet in order to improve torsional stiffness, efficiency, durability, lightness, cost, foot protection, and industrial workability.

In response, Applicants respectfully argue that the combination of Lepage and Saillet does not teach or suggest all of the claim limitations. Applicants note that, as disclosed in claims 1 and 15, the reinforcement means are “positioned **at least partially between** said [first and second] parts” (emphasis added). In contrast, Lepage does not teach or suggest a reinforcement means positioned at least partially between the first and second parts, i.e., between the rigid core and the envelope (as regarded by the Office Action). Lepage specifically indicates that the reinforcement means are not covered by the envelope (see column 2, line 67 - column 3, line 2), and thereby cannot be positioned at least partially between the rigid core and the envelope of supple material. In fact, Lepage even teaches away from the present invention by describing advantages associated with not covering the reinforcement means with the envelope of supple material (see column 2, lines 29-33). Further, Saillet does not remedy this deficiency, as it only relates to reinforcement for a boot. Therefore, the combination of Lepage and Saillet does not teach or suggest each and every element of the claimed invention and, hence, is not obvious over the present invention.

**§ 103(a) as allegedly unpatentable over Lepage in view of Saillet and in further view of Basso**

Claim 12 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lepage in view of Saillet, and in further view of Basso (U.S. Publication No. 2001/0018805). This rejection is respectfully traversed.

According to the Examiner, the combination of Lepage and Saillet relates to the boot disclosed in claim 1 of the present invention, and Basso discloses a boot with a frame extending transversely around the rigid core, between heel and toe, and obliquely rearward. In response, Applicants note that claim 12 is dependent upon, and therefore discloses the elements of, claim 1. With this in mind, Applicants reiterate the arguments above and assert that Lepage does not teach a sports boot comprising a reinforcement means positioned **at least partially between** the first and second parts. Notably, neither Saillet nor Basso, individually or combined, remedies

this deficiency. Therefore, the invention disclosed in claim 12 is not unpatentable over the combination of Lepage, Saillet, and Basso.

Accordingly, reconsideration and withdrawal of all rejections under 35 U.S.C. § 103(a) are respectfully requested

**CONCLUSION**

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in dark ink, appearing to read "Ronald S. Santucci", is written over a horizontal line.

Ronald S. Santucci

Reg. No. 28,988

Telephone: (212) 588-0800

Facsimile: (212) 588-0500